

REMARKS/ARGUMENTS

Claims 14-35 are now pending. Applicants affirm the election of Group II (claims 14-22) drawn to a filter assembly for removing pollutants from stormwater with traverse. Applicants, have canceled claims 1-13 and added new claims 23-35. Claims 23-35 largely correspond in substance to original claims 1-13, but are written so as to be expressly directed to a filter assembly "for removing pollutants from stormwater." Claims 23-35 therefore fall within the invention of Group II and should be examined with claims 14-22.

Claim Rejections – 35 U.S.C. § 103

Claims 14-22 are rejected under 35 U.S.C. § 103(a) as being obvious over Lenhart, Jr. et al. (U.S. 6,027,639) in view of Dolvet et al. (U.S. 5,649,639). Applicants disagree.

The combination of Lenhart, Jr. et al. with Dolvet et al. is improper because Dolvet et al. is not analogous art. Each cited reference must meet a two-step test to determine if it is analogous art and therefore properly asserted in an obviousness rejection. The first step is to determine whether the reference is "within the field of the inventor's endeavor." *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). If not, the reference may still be pertinent if it is "reasonably pertinent to the particular problem with which the inventor was involved." *Id.*

The inventors define their field of endeavor, by their specification and their claims. *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). In this case, the specification begins: "The invention relates to apparatus for the treatment of water, particularly stormwater, to reduce levels of contaminants such as trash and debris, sediment, heavy metals, oils and greases, organic toxins, and the like. Specifically, the invention provides a modular filter assembly that is capable of using a wide variety of filtration materials to provide various levels of stormwater treatment." The claims all begin their preambles: "A filter assembly for removing pollutants from

stormwater." Moreover, the specification teaches that the claimed filter assemblies are designed for use in applications where the assembly may become submerged in stormwater, and each of independent claims 14 and 23 expressly refers to stormwater in the body of the claim (i.e., claim 14 - "to prevent stormwater from contacting the check valve when the filter assembly is submerged in stormwater," and claim 23 - "preserving an air-filled void above the check valve when the filter assembly is submerged in stormwater").

Dolvet et al. discloses a vent device for use with a blow-molded receptacle 1. As stated by Dolvet et al., "a blow-molded receptacle 1 composed of a synthetic resin and provided at its bottom along one side wall an outlet fitting 19 which can have a cock 19a. The receptacle is intended to receive a flowable medium...and is provided with a top wall 1a having a venting device 2...." Col. 3, ln. 41-47. There is no reference in Dolvet et al. to filter assemblies for removing pollutants from stormwater. Moreover, while Dolvet et al. makes a vague reference to the possible ability of its venting device filter material to limit ingress of fine particles or moisture/water into the receptacle, there is no reference in Dolvet et al. suggesting that the receptacle and its associated venting device has any use in an environment where the receptacle can become submerged in liquid. Thus, Dolvet et al. is clearly outside the field of endeavor in which the inventors of the present application were operating.

Dolvet et al. also fails the second test because it is not a prior art reference which, "because of the matter with which it deals, would have commended itself to an inventor's attention in considering his problem." *In re Clay* at 656. It is improper to define the "problem" broadly, in hindsight, in order to legitimize an improper reference citation. Applicants note that the court in *In re Clay* held that "[a] person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies." A reference directed to a different purpose than the invention provides less motivation or occasion to an inventor to consider it. *Id.* Here, Dolvet et al. does not address the problem of stormwater filtration, rather it is concerned with filtration of air rushing into the container. See, e.g., col. 1,

ln. 44-48. Moreover, the more specific problem addressed by the invention of claims 14 and 23 is clearly described in paragraphs [0013] and [0014] of the present application, that of compromising the operation of a check valve (such as that shown in U.S. Patent No. 6,649,048, which is the issued patent for the parent application) due to an arrangement where stormwater (and its associated particulates/debris) reach the check valve when the stormwater filter assembly is submerged. As previously stated, while Dolvet et al. makes a vague reference to the possible ability of its venting device filter material to limit ingress of fine particles or moisture/water into the receptacle, there is no reference in Dolvet et al. suggesting that the receptacle and its associated venting device has any use in an environment where the receptacle can become submerged in liquid. Dolvet et al. does not expressly mention any advantage relating to eliminating fouling of its check valve. Thus, one of ordinary skill in the art would not look to Dolvet et al. to solve a potential stormwater filter assembly check valve problem caused by submersion of the filter assembly in stormwater.

Even if Dolvet et al. is considered analogous art, the combination of Lenhart et al. and Dolvet et al. fails to disclose or suggest Applicants' invention as claimed. Specifically, Applicants' claimed invention is an improvement over stormwater treatment apparatus such as that disclosed by Lenhart et al. Claim 14 recites *inter alia* "a check valve in the hood, configured to permit air to escape the filter assembly in response to rising stormwater within the hood, but to prevent air from entering the filter assembly; and a check valve cap that is coupled to the hood, where the check valve cap is configured to permit air to escape the check valve and to prevent stormwater from contacting the check valve."

As conceded by the Examiner, Lenhart et al. fails to disclose a check valve or a check valve cap. To overcome these deficiencies, the Examiner relies on Dolvet et al. as teaching a check valve 120 and a check valve cap 113. However, Dolvet et al. states that its check is designed to "allow the contents of the receptacle to "breathe" in the sense described above without permitting a rush or air into the receptacle until the cover" is removed (see Dolvet et al at col. 5, line 11-15). Thus, the check valve is designed to permit some air flow in both directions

(into and out of the receptacle). This type of check valve operation is undesired in connection with the claimed stormwater filter assembly, as most clearly reflected with respect claim 23, as such a two way air flow could prevent the claimed siphon (claim 23) from being established, or at the very least limit its effectiveness. Moreover, there is no teaching or suggestion in Dolvet et al. that would indicate that if the Dolvet et al. receptacle were submerged in stormwater the cap 113 would "prevent stormwater from contacting the check valve" as required in claim 14 or preserve "an air-filled void above the check valve" as required in claim 23. Dolvet et al. teaches that slits 115 between adjoining elements 114 serve to vent the interior of the hollow body 104. Col. 4, ln. 65 – col. 6, ln. 1. and there is no indication that water would not be able to enter through those slits and reach the check valve, displacing the air around the check valve, if the receptacle were submerged.

For the reasons noted above, Lenhart et al. and Dolvet et al. are not properly combinable, and, even if combined, fail to disclose or fairly suggest the invention of claims 14 or 23. Accordingly, all of claims 14-35 are believed patentably distinguishable over the art and allowance of the application is requested.

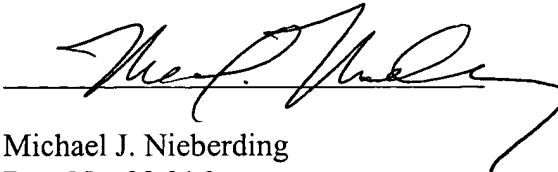
It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Commissioner is hereby authorized to charge any

additional fees which may be required by this paper, or to credit any overpayment to Deposit Account 20-0809. Prompt and favorable examination is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Michael J. Nieberding", written over a horizontal line.

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